

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Steven Rizzi et al.

Serial No.: 09/876,173

Filed: June 8, 2001

For: System and Method of Providing
Advertising on the Internet

Atty. Docket No.: 000479.00023

Group Art Unit: 3622

Examiner: Janvier, Jean D.

Confirmation No.: 5726

REPLY BRIEF

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is a Reply Brief filed in response to the Examiner's Answer of mailing date November 9, 2009, and in support of Appellants' October 31, 2008, Notice of Appeal. This Reply Brief is not intended to serve as a substitute for Appellants' Appeal Brief filed October 31, 2008, but rather, as a supplement to the Appeal Brief in order to more fully clarify the issues for appeal.

Please charge any necessary fees in connection with this Reply Brief to our Deposit Account No. 19-0733.

STATUS OF CLAIMS

37 C.F.R. § 41.37(c)(1)(iii); MPEP § 1208 (I. Reply Brief)

Claims 1-4, 8-9, and 11-40 are pending and rejected. Claims 5-7 and 10 have been previously canceled. Claims 1, 21, 30, and 37 are independent claims. Appellants hereby appeal the rejection of claims 1-4, 8-9, and 11-40.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

37 C.F.R. § 41.37(c)(1)(vi); MPEP § 1208 (I. Reply Brief)

The remaining grounds of rejection on appeal include:

- Claims 1-4, 8-9, and 11-40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,804,659 to Graham (hereinafter referred to as "*Graham*").

The Examiner has now dropped the rejections of claims 1-4, 8-9, and 11-40 under 35 U.S.C. § 102(b) as being anticipated by a PR Newswire article, "Web Media Revolutionizes Online Advertising Industry," published on Dec. 5, 1996, and claims 1-4, 8-9, and 11-40 under 35 U.S.C. § 103(a) as being unpatentable over Dietsch et al. (U.S. Pub. App. No. 2004/0143499, hereinafter referred to as *Dietsch*) in view of *Graham*.

ARGUMENT

37 C.F.R. § 41.37(c)(1)(vii) ; MPEP § 1208 (I. Reply Brief)

1. Rejection of Claims 1-4, 8-9, and 11-40 under 35 U.S.C. § 102(e) over *Graham*.

The *Examiner's Answer* rejects claims 1-4, 8-9, and 11-40 as being anticipated by *Graham*. Appellants respectfully traverse this rejection.

Initially, Appellants again object to the narrow and improper reading of the claim language in the *Examiner's Answer*. Specifically, the *Examiner's Answer* begins the argument for all rejections stating, "[I]n 'no user profiling data are forwarded to the advertising server 140 for collection', **the advertising server 140 is an external advertising server or a third party advertising server that should not collect or access the user's profile data. The claims will be interpreted accordingly.**" (*Examiner's Answer*, p. 3). The *Examiner's Answer* improperly narrows the claim language of independent claims 1, 21, 30, and 37, and thus all of the pending claims 1-4, 8-9, and 11-40, by requiring an advertising server that must be external or a third party server that should not collect or access a user's profile data. Such a limitation in rejecting the claims is completely improper. For example, with respect to Appellants' claim 1, an advertising server of various elements is recited. There is nothing in the claim language of claim 1, nor any other claim, to require that the advertising server be an "external advertising server or a third party advertising server" as required by the claims. With respect to claim 1, the claim language speaks for itself and unnecessary and improper limitations are simply not allowed.

Further, the Examiner's Answer points to multiple alleged embodiments of *Graham* and then admits, "Here, the advertising server is part of the internal system and hence, the user's profile data are not collected and provided to any third party or external advertising server, but

rather **are collected** and used internally for targeting the users.” (*Examiner's Answer*, p. 5, emphasis added). As such, under Graham, user profiling data is collected as admitted in the *Examiner's Answer*.

Secondly, the *Examiner's Answer* cites to one part of the specification that recites that “data, which might be used to profile the user, is not collected. No user profiling data is forwarded to the advertising server 140 for collection” (*Examiner's Answer*, p. 7, from Appellants' original specification, para. [0043]). As previously admitted in the *Examiner's Answer*, Graham collects user profile data. The *Examiner's Answer* then states that the clause “wherein no user profiling data is forwarded to the advertising server,” “may be considered as an ‘Intended Use’ recitation.” (*Examiner's Answer*, p. 7). Appellants respectfully disagree and contend that the wherein clause represents a requirement of the system of claim 1 that the advertising server is not forwarded user profiling data.

Thirdly, for the first time in the *Examiner's Answer*, specific claim limitations of any particular claim are cited to particular parts of the Graham reference. Specifically, the *Examiner's Answer* addresses the embodiment of Figs. 1A-1C in Graham and specific specification recitations included. With respect to Appellants' claim 1 feature, “wherein no user profiling data is forwarded to the advertising server,” the *Examiner's Answer* relies on column 6, lines 27-47 of Graham. This cited portion of Graham describes FIG. 1C. According to Graham, “FIGS. 1A-1C illustrate a representative system for implementing a particular embodiment according to the present invention.” (Graham, col. 3, ll. 51-53). The Graham system uses a personal profile of a user. (Col. 6, ll. 7-11). In describing FIG. 1B, the Graham system includes a concept comparator 106 that compares **user concept output 20 from profile content recognizer 102** and advertiser concept output 22 from advertisement concept recognizer 104 **to produce as an output a “best ad,” 30, an advertisement targeted to the user of client browser 12a based on the content of the document, the user's interests and the content of the advertisements.** (Col. 5, ll. 58-64, emphasis added). Advertisements are then displayed to users based on user's concepts of interest. (Col. 6, l. 17). Under the Graham system, a user profile file is created and advertisements are then shown based upon this user profile file.

Finally, the *Examiner's Answer* states that Graham teaches several embodiments that do not rely upon the user's profile to display an advertisement to the user and that do not require that the ‘user profile data’ be forwarded to the advertising server 10.” (*Examiner's Answer*, p.

10). Yet, the cited portions of *Graham* for support in rejecting the claims are directed to the description of FIGS. 1A-1C, that include collection of user profile data noted above, and FIGS. 11A-11G. As noted for each illustrative example of FIGS. 11A-11G, the specification of *Graham* states, “[t]hese advertisements have been selected using the relevancy determining techniques described herein” (*Graham*, col. 15, ll. 17-19 for FIG. 11A; col. 15, ll. 35-36 for FIG. 11B; col. 15, ll. 52-54 for FIG. 11C; col. 16, ll. 6-8 for FIG. 11D; col. 16 ll. 27-29 for FIG. 11E; col. 16, ll. 57-59 for FIGS. 11F and 11G). The relevancy determining techniques described in *Graham* all include profiling a user and collecting information that is forwarded to an advertising server.

Independent claims 1, 21, 30, and 37:

Graham fails to teach or suggest every feature of claim 1. Claim 1 recites, among other features, “wherein no user profiling data is forwarded to the advertising server.” As recited in claim 1, at least one applet reads textual content displayed on the web browser and the advertising server compares the read textual content to keyword data to determine whether display an ad on the web browser. No data is forwarded to the advertising server. The *Graham* system requires generation of a user profile file in order to generate an advertisement for a user. Under the *Graham* system, advertisements are only displayed based upon the generated user profile file.

Claim 1 is patently distinct from *Graham* for at least the reason that *Graham* displays ads based upon a user profile file forwarded to an ads database. The *Examiner Answer's* attempt to limit the claim language to being external from a designated internal system or providing to a third party is improper as such a limitation is simply not within the claim. Therefore, because *Graham* fails to teach or suggest each and every feature of claim 1, withdrawal of the present rejection is respectfully requested.

Claims 21, 30, and 37 include similar language as recited above with respect to claim 1. For at least similar reasons as recited above with respect to claim 1, *Graham* fails to teach or suggest every feature of claims 21, 30, and 37. As such, claims 21, 30, and 37 are allowable over the art of record.

Claims 2-4, 8-9, 11-20, and 31-34, which depend from claim 1, are allowable over the art of record for all the reasons given above concerning their respective base claim, and further in view of the novel features recited therein. Claims 22-29 and 35, 36, and 38-40, which depend

from claims 21, 30, and 37, are allowable over the art of record for at least the same reasons as their ultimate base claim.

Dependent claim 23:

Claim 23 recites, among other features, “displaying no ad when said textual content does not match said keyword data.” The *Examiner's Answer* states that Graham discloses that if the use of only highlighted words does not yield an advertisement with sufficient relevancy score, R.sub.j, then other phrases contained in the viewing area can be used as the matching criteria for the collection of advertising concepts useful in displaying one or more targeted advertisements to the user. Under *Graham*, Advertisement content recognizer 104 produces an output 22 comprising one or more advertising concepts from database 18 that are relevant to the contents of document 100. (Col. 5, ll. 55-58). As even admitted in the *Examiner's Answer*, “if the use of only highlighted words does not yield an advertisement with sufficient relevancy score, R.sub.j, then other phrases contained in the viewing area can be used as the matching criteria for the collection of advertising concepts useful in displaying one or more targeted advertisements to the user” (emphasis added). As such, *Graham* always displays an ad. *Graham* fails to teach or suggest that advertisements are not displayed when there is no textual match to keyword data.

Dependent claims 34, 35, and 36:

Still further, dependent claim 34 recites, among other features, “wherein no data is collected to profile a user of the web browser.” Under *Graham*, advertisements are then displayed to users based on user's concepts of interest. (Col. 6, l. 17). By the very operation of *Graham*, user data must be collected and used for the user's concepts of interest. Therefore, *Graham*, by its very operation, cannot perform the features of claim 34. As such, for at least this additional reason, *Graham* fails to teach or suggest the features of claim 34.

Dependent claims 35 and 36 include similar features as recited above with respect to Appellants' claim 34. As described above with respect to claim 34, *Graham*, by its very operation, cannot perform the features of claims 35 and 36.

Dependent claim 38:

Dependent claim 38 recites, among other features, “wherein no user profiling data is forwarded from the computer to the advertising server.” No data is forwarded to the advertising

server. The *Graham* system requires generation of a user profile file in order to generate an advertisement for a user. Under the *Graham* system, advertisements are only displayed based upon the generated user profile file.

Claim 38 is not anticipated by *Graham* because, as described above, *Graham* displays ads based upon a user profile file forwarded to an ads database. Specifically, the claim 38 feature, "wherein no user profiling data is forwarded from the computer to the advertising server," recites absolutely **nothing** as to the advertising server being of a third party or external. Therefore, because *Graham* fails to teach or suggest each and every feature of claim 38, the rejection is improper.

CONCLUSION

For all of the foregoing reasons, Appellants respectfully submits that the final rejection of claims 1-4, 8-9, and 11-40 is improper and should be reversed.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated: December 29, 2009

By: /John M. Fleming/
John M. Fleming
Registration No. 56,536

1100 13th Street, N.W.
Suite 1200
Washington, D.C. 20005
Tel: (202) 824-3000
Fax: (202) 824-3001